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10/009,605	03/20/2002	Jean-Marc Frances	022701-968	4221

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EXAMINER

BERMAN, SUSAN W

ART UNIT PAPER NUMBER

1711

DATE MAILED: 01/23/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

10/009,605

Applicant(s)

FRANCES ET AL.

Examiner

Susan W Berman

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 17 December 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-11 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-11 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.  
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

*Response to Amendment/Arguments*

Rejections under section 112: The words "formed by" suggest that the borate salt is employed to form an initiator salt thus making it unclear what the structure of the resulting initiator salt might be. If applicant intends to claim a borate salt of an onium cation or a borate salt of an organometallic cation, it should be so stated. If the initiator salt is derived from an onium borate or from an organometallic borate, it should be stated what the structure of the derived initiator salt is or how (by what reaction) the initiator salt is prepared. Does applicant mean a borate salt is reacted with an onium salt? If so it should be so stated and the structure of the initiator salt resulting should be clearly set forth. With respect to the terms "onium salts", oxoisothiochromanium salts", etc. the formulae set forth are formulae of cations not formulae of salts.

Rejection under section 103: Applicant argues that unexpected results are obtained when solvent component C is employed in the compositions required for use in the instantly claimed method. This argument is not persuasive because the data in the comparative table relied upon for evidence of unexpected results has not been presented in the form of a Declaration signed by applicant. There is no comparative data included in the specification as filed.

*Specification*

The abstract of the disclosure received 12-17-2003 is accepted.

*Claim Rejections - 35 USC § 112*

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1-11 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

(1) Claim 1, lines 9-13, the phrase "group consisting essentially of" must be followed by a list of members of the group ending with "and...". It is suggested that the lines read "group consisting essentially of at least one heterocyclic functional unit having one or more electron-donating atoms, at least one ethylenically unsaturated functional unit that is substituted by at least one electron-donating atom that enhances the basicity of the  $\pi$  system and mixtures thereof";

(2) claim 1, lines 15-17, it is not clear what is meant by initiator salt "formed by a borate of an onium...or of an organometallic complex...". Does applicant intend to claim borate salts only or to claim an onium borate salt or an organometallic complex salt? Is the initiator salt intended a borate salt of onium cation or a borate salt of an organometallic cation? If so, it should be so stated. Is the initiator salt a salt formed by a borate of an onium cation or a borate of an organometallic cation reacted with some other material? Does "formed by" mean formed by a reaction?

(3) claim 1, line 18, there is no antecedent basis for the recitation in line 16 of "the cationic entity of said borate". In line 20, it is suggested that "onium salts" should be "onium cations". The phrase "onium salts" implies salts other than borate salts are included. See also, line 32 "oxoisothiochromanium salts", line 35 "sulfonium salts", line 91 "organometallic salts".

(4) In claim 1, line 21, the new formula (I) is missing the positive charge on the onium cation.

(5) In claim 1, the definition of (C), the "nonorganosilicon" compound is not clearly differentiated from the "organic" compounds. It appears from the specification at pages 35-36, that applicant intends to set forth "nonorganosilicon organic compounds" (C<sub>1</sub>) possessing CFG and optionally SFG groups and organosilicon compounds (C<sub>2</sub>). There is no disclosure of nonorganosilicon compounds other than epoxies or vinyl ether organic compounds.

In claim 4, it is not known what an "oxethane" group is. Does applicant intend to set forth "oxetane"?

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Claim 7, line 9, "and/or from" should be changed to "and" in order to recite a proper Markush "group consisting of..."

Claim 8: "B.p." should be "B.P." or "b.p."

*Claim Rejections - 35 USC § 103*

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-11 are rejected under 35 U.S.C. 103(a) as being unpatentable over FR 2 757 870 in view of EP 0 522 703. FR '870 discloses a cylinder-head gasket coating method that includes employing a silicone composition containing a polyorganosiloxane and an initiator identical to those set forth in instant claim 1. FR '870 does not teach reactive diluents corresponding to component (C) of the compositions used in the instantly claimed method. EP '703 teaches the use of a reactive diluent for improving the performance of a bis(aryl)iodonium salt catalyst for epoxysilicone resins. The resins and catalysts disclosed are analogous to those taught by FR '870. EP '703 teaches that the reactive diluents provide improved miscibility of the catalyst and compositions having improved stability, improved hardening performance and improved anti-adherence. EP '703 does not disclose using the compositions for coating cylinder-head gaskets.

It would have been obvious to one skilled in the art at the time of the invention to employ the reactive diluent taught by EP '703 in the analogous compositions disclosed by FR '870 for improving the performance of the catalyst, as taught by EP '703. One of ordinary skill in the art at the time of the invention would have been motivated by a reasonable expectation of providing improved miscibility of

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the catalyst and compositions having improved stability, improved hardening performance and improved anti-adherence.

### *Double Patenting*

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 1-11 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-13 of U.S. Patent No. 6,423,378. Although the conflicting claims are not identical, they are not patentably distinct from each other for the following reasons. The instant claims include a process for impregnation of a coating on sheet gaskets as set forth in the claims of US '378 wherein the same initiator salts and the same polyorganosiloxanes are set forth in the instant claims and in the claims of US '378. The comprising language of the instantly claimed process encompasses the additional step of preimpregnation or precoating set forth in the claims of US '378. It would have been obvious to one skilled in the art at the time of the invention to employ the composition set forth in the claims of US '378 for impregnating a sheet gasket as set forth in the instant claims because the claims of US '378 recite carrying out impregnation on sheet gaskets with the composition set forth. One of ordinary skill in the art at the time of the invention would have been motivated by a reasonable expectation of successfully impregnating a sheet gasket, as taught by the claims of US '378.

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*Conclusion*

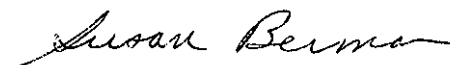
Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Susan W Berman whose telephone number is 571 272 1067. The examiner can normally be reached on M-F 9:30-6:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James Seidleck can be reached on 571 272 1078. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 571 272 1200.



Susan W Berman  
Primary Examiner  
Art Unit 1711

SB

1/15/04